REMARKS

In an Official Action dated March 17, 2005, the Examiner imposed a restriction requirement between the prosthesis claims recited in claims 1-25 and the method for implanting a prosthesis claims recited in claims 26-49. Applicant requests that the Examiner reconsider the restriction requirement in light of the following discussion.

The Examiner proposed three alternative uses of the product to support the restriction requirement:

(1) if the method requires a first or second wing;
(2) if the product is placed on the femur without resecting a portion of the femur;
(3) if the product is simply used as a teaching device.

Applicant is unclear what the Examiner means by the first proposed alternative. How does a method include a first or second wing, and how is that different from what is claimed in claims 26-49?

In claim 1, the prosthesis comprises an intercondylar notch portion having a first wing extending distally and curving posteriorly and a second wing extending distally a curving posteriorly away from the first wing. In claim 26, the method recites the step of resecting a portion of the intercondylar notch and implanting a femoral prosthesis over the resected portion of the intercondylar notch. In other words, in the product claim, the prosthesis is configured to overlie a portion of the intercondylar notch; in the method claim, a prosthesis is implanted over a portion of the intercondylar notch. How are these distinct as required by MPEP §806.05(h)?

The second proposed alternative is not a viable alternative. Before

implanting a knee prosthesis, a portion of the bone must be resected so that the prosthesis can be implanted into the resected portion. Applicant does not know of an accepted medical procedure in which a prosthesis of the type claimed in claims 1-25 could be implanted without resecting a portion of the femur. Accordingly, the second alternative does not meet the Examiner's burden under MPEP §806.05(h).

The third proposed alternative also fails to meet the Examiner's burden. If a product and a process of use are distinct simply because the product could be used as a teaching device then every product is necessarily distinct from the process of use, because theoretically every product could somehow be used as a teaching device.

Further still, if the prosthesis is used as a teaching device, it would probably be used in connection with teaching the method for implanting the prosthesis. Does the Examiner contend that the use of the prosthesis as a teaching device would be to simply hold it up and say "look at this prothesis"? Again, if this is the use that the Examiner contemplates, then every product is necessarily distinct from every method of use, which is clearly not what is contemplated by MPEP §806.05(h). On the other hand, the most likely use of the product as a teaching device would be to teach how to implant the product, which is not necessarily distinct from the product claims, as required by MPEP §806.05(h).

In light of the foregoing, Applicant requests that the Examiner reconsider the restriction requirement and examine claims 1-49. Although Applicant believes that the Examiner has not met his burden to require restriction, in order to make this response complete, Applicant elects Group I, which includes claims 1-25.

In light of the foregoing, Applicant believes that this application is in form for substantive examination. The Examiner is encouraged to contact Applicant's

undersigned attorney if the Examiner believes that issues remain that would prevent the Examiner from examining the claims.

Respectfully submitted,

DANN, DORFMAN, HERRELL & SKILLMAN
A Professional Corporation
Attorneys for Applicant(s)

By_____
Stephen H. Eland
PTO Registration No. 41,010

Telephone: (215) 563-4100
Facsimile: (215) 563-4044

Petition for Extension Under 37 CFR §1.136(a)

Applicant's undersigned Attorney hereby petitions for an extension of time of **TWO** months beyond the time period set in the last office communication. The proper fee is enclosed as identified in the enclosed Fee Transmittal form.

June 17, 2005
Date of Certificate

_____
Stephen H. Eland
PTO Registration No. 41,010